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EXAMINER

FERNSTROM, KURT

ART UNIT PAPER NUMBER

3712

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/611,705

Applicant(s)

TITUS, PETER F.

Examiner

Kurt Fernstrom

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 7-9, 11, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodman. Goodman discloses in Figures 1 and 4 and in column 3, line 35 to column 4, line 25 an apparatus comprising a rectangular substrate 26 having a predetermined size and configuration, wherein information pertaining to a particular book is printed on the substrate. While Goodman does not explicitly disclose that definitions of words are provided on the substrate, Goodman does disclose that various types of information, including descriptions of characters and answers to questions, are provided. Words and definitions are very analogous to characters and their descriptions, and would have been an obvious variation to one of ordinary skill in the art for the purpose of providing a reference guide to selected words. The phrase "for marking a page in a predetermined book" is functional language, which describes the intended purpose of the device rather than providing further structural limitation, and thus is not deemed to have patentable weight. The substrate of Goodman is physically capable of being used to mark a book. With respect to claims 2 and 3, while the material used to form the substrate is not explicitly disclosed, Official Notice is taken

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that it is well known to use paper for sheets such as that of the Goodman device. With respect to claim 7, Official Notice is taken that in providing definitions of words, it is well known too utilize synonyms. Such a feature would have been obvious for the purpose of enabling a user to easily and quickly determine the definition of a word. With respect to claim 9, while the size of the sheet is not explicitly disclosed, Official Notice is taken that reference sheets are provided in many different sizes. The specific size claimed would have been an obvious variation. With respect to claim 11, Official Notice is taken that standard print is, well, standard for sheets containing printed matter. With respect to claim 13, the word key logo does not appear to have a specific function apart from trademarking or decorative purposes, and as such is an aesthetic choice of design. With respect to claim 14, Goodman discloses in Figure 4 that the Title of the book is provided on the substrate. Modification to include the author's name would have been obvious for the purpose of providing additional detail regarding the book.

Claims 4, 5 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodman in view of Renegar. Goodman discloses all of the limitations of claims 4 and 5 with the exception of the lamination. Providing lamination to printed matter including reference lists is well known, as disclosed for example in column 6, lines 15-18 of Renegar. It would have been obvious to one of ordinary skill in the relevant art to modify the device of Goodman by providing a sheet of laminated paper for the purpose of enhancing the durability of the sheet. With respect to claim 5, it is well known, when laminating an article, to use plastic. Goodman further discloses or suggests all of the limitations of claims 16-20 with the exception of the folding

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creases. Providing folding creases to printed matter including reference lists is well known, as disclosed for example in Figures 4-9 of Renegar. It would have been obvious to one of ordinary skill in the relevant art to modify the device of Goodman by providing a sheet of laminated paper for the purpose of enhancing the durability of the sheet. At least 8 surfaces are shown in Figure 6 (the four shown, and the four on the rear side).

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goodman in view of Renegar, and further in view of Finkleston. Goodman as viewed in combination with Renegar discloses all of the limitations of the claim with the exception of the magnifying feature. Finkleston discloses in column 5, lines 10-59 a laminated article comprising an integral magnifying lens. It would have been obvious to one of ordinary skill in the relevant art to modify the device of Goodman as viewed in combination with Renegar by providing a magnifying feature for the purpose making the substrate easier to read.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goodman in view of Batjuk. Goodman discloses all of the limitations of the claim with the exception of the bold print. Batjuk discloses in the Figure an apparatus comprising a substrate having words and definitions, where the words are printed in boldface, and the definitions are provided in standard print. It would have been obvious to one of ordinary skill in the relevant art to modify the device of Goodman by providing boldfaced words for the purpose of making them easier to distinguish from the definitions.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goodman in view of Marshall. Goodman discloses all of the limitations of the claim with the exception of the words being in alphabetical order. Marshall discloses in Figure 2A an apparatus comprising a substrate for use with a book having letters and sounds, where the letters are provided in alphabetical order. It would have been obvious to one of ordinary skill in the relevant art to modify the device of Goodman by providing words in alphabetical order for the purpose of making them easier to find on the substrate.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goodman in view of Leon. Goodman discloses all of the limitations of the claim with the exception of the magnifying slide. Leon discloses in Figure 1 and 6 and in column 2, lines 61-64 an apparatus comprising a substrate having printed matter thereon, further comprising a magnifying slide 22. It would have been obvious to one of ordinary skill in the relevant art to modify the device of Goodman by providing a magnifying slide for the purpose of making the substrate easier to read.

### ***Response to Arguments***

Applicant's arguments filed on March 29, 2004 have been fully considered but they are not persuasive.

The arguments concerning the rejections made under 35 USC 112 are persuasive. One of ordinary skill in the art would understand the meaning of the claim language. These rejections have been withdrawn.

The arguments concerning the rejections under 35 USC 103 are unpersuasive, particularly with respect to the Goodman reference. While Goodman contains several features not recited in the present invention, including a masking means, pockets, five layers stitched together and so forth, claim 1 does not preclude the existence of these additional features. Goodman clearly discloses a substrate having a predetermined configuration, with information pertaining to a book printed on the substrate. There is nothing in the claims which is not disclosed or suggested by the prior art. Also, applicant is correct in stating at pages 9-10 that many objects, including that of Goodman, can be used as bookmarks in the broadest sense. In fact, such a use is explicitly disclosed at column 2, lines 53-56 of Goodman. While applicant asserts that Goodman does not disclose or suggest the present invention, there is no indication of specific limitations in the claims which are not suggested by Goodman. Rather the arguments seem primarily directed to the assertion that there are features of Goodman which are not suggested by the present invention.

In addition, applicant is incorrect in asserting that the substrate of Goodman comprises polyethylene. Goodman discloses in column 3, lines 35-45 that the **holder** of the substrate having printed indicia thereon comprises transparent plastics such as polyethylene. The substrate having printed indicia thereon is the sheet 26, , whose material is not disclosed. Paper and cardboard, including laminated variations thereon, are a well known means of providing printed indicia. Laminated sheets are thin, and would be usable with the masking device of Goodman. Additionally, the sheet is

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removable from the masking device, so lamination provides the advantage of making the sheet itself more durable when not located in the masking device.

With respect to the arguments concerning Finkelston, Finkelston discloses at column 3, lines 29-42 an embodiment whereby a magnifying means is adhered to the credit card prior to lamination. The magnifying means is in the plastic laminate, and is not merely placed by the user over the card, but is a permanent, immovable part of the apparatus. As a result, the teachings of Finkelston read on the claim language of claim 6.

With respect to the arguments concerning Marshall, Marshall discloses information which is arranged in alphabetical order. While Marshall also discloses division into categories of long vowels, short vowels and consonants, the letters are alphabetical within those categories, as disclosed several times in the specification. In particular, column 11, lines 59-67 discusses the alphabetical arrangement of information. The teachings of Marshall suggest the limitations of claim 12.

With respect to the arguments concerning Leon, Goodman discloses in Figures 5 and 6 and in column 2, lines 57-68 and column 4, lines 26-37 an embodiment where the substrate is not placed in a separate holder, but has adhesive strips or paint disposed thereon. A magnifying slide would be easily usable with this embodiment, as it is not placed in any holders having pockets or such. Further, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined



teachings of the references would have suggested to those of ordinary skill in the art.

See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). It should also be noted that different references were used to make different rejections, and no more than three references were used in any individual rejection.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (703) 305-0303. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KF  
June 10, 2004

*Kurt Fernstrom*  
Kurt Fernstrom